

08-19-04

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Dkt. 45113/RDK

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#24

Applicants : KAST, Wybe Martin et al.
U.S. Serial No. : 08/170,344
U.S. Filing Date : March 30, 1994
For : PEPTIDES OF HUMAN PAPILLOMA VIRUS FOR USE IN
HUMAN T CELL RESPONSE INDUCING COMPOSITIONS



Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RENEWED PETITION TO REVIVE UNDER 37 C.F.R. 1.137(b)
AND/OR TO SUSPEND THE RULES UNDER 37 C.F.R. §1.183

Sir:

Applicants hereby renew their petition to revive U.S. Patent Application Serial No. 08/170,344, filed on 30 March 1994. In support of the renewed petition, applicants submit the following:

- (1) A Declaration of Robert D. Katz, Esq., with exhibits in support of the petition, which includes the required statement that the entire delay in filing the required reply from for the due date for the reply until the filing date of a grantable petition to revive was unintentional;
- (2) A Declaration of Mark Einerhand, applicants' European Patent Attorney with Exhibits;
- (3) A Declaration of Thomas F. Moran, Esq.;
- (4) A Terminal Disclaimer with the filing fee; and
- (5) A Change of Address form.

Applicants: KAST et al.
U.S. Serial No.: 08/170,344
Page 2

Applicants respectfully request that the Commissioner review and grant the present petition, and forward the application for further examination on the merits.

DECLARATION OF ROBERT D. KATZ, ESQ.

I, Robert D. Katz, hereby declare as follows:

1. I am an attorney-at-law admitted to practice in the State of New York, and before the United States Patent & Trademark Office (Registration No. 30,141). I am a partner at Cooper & Dunham LLP, 1185 Avenue of the Americas, New York, NY 10036. All statements made herein are based upon personal knowledge, except where stated to be on information and belief.
2. U.S. Patent Application Serial No. 08/170,344 was duly filed on March 30, 1994 by Thomas F. Moran, Esq. a former partner at Cooper & Dunham, who was of counsel to Cooper & Dunham LLP at the time.
3. At the time Serial No. 08/170,344 (Attorney Docket No. 45113) was filed, Mr. Moran was in the process of retiring from the practice of law, and was asked by the partners in the firm to begin turning over responsibility for his remaining clients to other partners in the firm. I was asked by Mr. Moran to assume representation of Vereenigde Octrooibureaux, a European Patent firm located in The Hague, The Netherlands, who had retained Mr. Moran to file and prosecute U.S. applications on behalf of its European clients.
4. New matters from Vereenigde were supposed to be sent directly to me, and existing matters were supposed to be turned over by Mr. Moran.
5. Apparently, this file never got turned over to me, and Mr. Moran continued prosecution thereof. I was unaware of its existence at the time Mr. Moran retired. When Mr. Moran formally retired from the firm in November, 1996, he did not inform me of the existence of this file, nor did he present me with a list of pending Vereenigde matters. He

did, however, ask me to assume representation of at least one other pending Vereenigde matter.

6. As of October 30, 1994, Cooper & Dunham moved its offices from 30 Rockefeller Plaza, New York, New York to 1185 Avenue of the Americas, New York, New York. A mail forwarding request was filed by the firm with the U.S. Postal Service, and mail was forwarded for at least a year. Each partner or other attorney in the firm was asked to notify his or her clients, as well as the Patent & Trademark Office and the Courts about the address change on matters for which he or she was responsible so that mail would be directed to the proper address. Memoranda reminding attorneys to do this were sent out to attorneys in the firm. A search was made for an example of such a memorandum, but it could not be located.

7. I have reviewed the file for this docket and did not locate a change of address form sent to the Patent & Trademark Office (PTO) at any time after 1994. I note that when Mr. Moran wrote to the PTO, he used the proper address on correspondence, although he apparently never formally notified the PTO of the address change in this case. See, e.g. Application Serial No. 08/170,344, Paper Nos. 11, 12, 14 and 15. As a result, PTO correspondence for this application continued to be sent to the 30 Rockefeller Plaza address.

8. On information and belief, the mail forwarding request expired sometime in 1995 or 1996. The second Office Action mailed on August 23, 1995 was received on August 28, 1995 (Exhibit 1). The address thereon was 30 Rockefeller Plaza, so it was apparently forwarded by the Post Office to the firm's new address, although the envelope is unavailable, so there is no way to verify this. A response was timely filed on February 23, 1996 by Mr. Moran, together with a request for a three month extension (Paper Nos. 14 and 15). The

return postcard supplied by the firm had printed thereon the new address, and was mailed with the response to the Office Action. It was stamped by the PTO as received and received back by our docketing clerk on March 13, 1996. I attach a copy thereof as Exhibit 2.

9. Thereafter, no mail was received for this docket. More particularly, applicants did not receive the Office Action dated June 14, 1996, nor the Notice of Abandonment dated January 23, 1997. Indeed, the firm was unaware that these items had been mailed to the firm. I enclose a recent print out from our docketing computer confirming that we did not receive these documents (Exhibit 3). No reminders were given to the responsible attorney because the Office Action was never received. I also enclose a copy of the cover of the prosecution file (Exhibit 4), showing the absence of receipt of the third office action. The latest document filed in the prosecution file is the return postcard dated March 13, 1996 (Exhibit 2), mentioned above. Any additional mail would be filed here and there are no such documents.

10. On information and belief, I understand that many Examiners in the PTO have a practice of calling attorneys of record to see whether the failure to respond to an Office Action was intentional or unintentional. We have no information concerning whether a telephone call was received by Mr. Moran or by any other attorney in this firm concerning this application. We are unable to locate any phone message records from that time either in the file or elsewhere. Both Mr. Moran and his secretary have retired.

11. Accordingly, applicants' undersigned successor attorney was unaware of the existence of this file, the June 1996 Office Action, or the Notice of Abandonment. Neither the Office Action of June 1996 nor the Notice of Abandonment of January 1997 was received by this firm.

12. On around December 10, 1997, our office received a letter from Vereenigde relating to this application, and it apparently went unanswered (Exhibit 5). A second letter dated January 27, 1998 was directed to me (Exhibit 6). The letter from applicants' European attorney asked for a copy of the claims as amended in the application. I sent a letter to Vereenigde on January 28, 1997 enclosing the claims as amended (Exhibit 7), but did not notice that the prior Office Action's still had the old firm address thereon, nor did I notice the lack of a change of address notice in the file. I did not review the file except to locate the original claims and any amendments, so that my secretary could retype or copy them. I did not check the status of the application with the PTO, so I was unaware of the abandonment of the application. At that time, on information and belief, PALM was unavailable on the Internet. I did not check the status of the application, nor did the firm have a system in place to remind attorneys to check the status of pending applications. Such a system has been recently instituted, as now required by the PTO. As a result, the present application sat in our file room, with personnel at the firm unaware of its existence or its abandonment.

13. I received an inquiry on January 20, 2004 from Vereenigde, who asked about the status of this application (Exhibit 8). When I received the letter, we checked the file in our office and the USPTO website for its status.

14. We learned from PAIR that the application had gone abandoned. On around February 5, 2004, we asked a Washington associate to order the file and copy the latest Office Action and the Notice of Abandonment. We reported the abandonment to our client in the Netherlands.

15. On February 19, 2004, we called our Washington associate again to learn if the file had been located by the PTO. Our associate reported that it still had not been located.

As of February 27, 2004, the file had not been located by the PTO. We therefore reviewed the file to see if we could contact the Examiner to whom it was assigned to help us locate file.

16. We successfully contacted Examiner Christine Nucker to discuss the matter. The file was apparently still with the group, who on information and belief, was in the process of moving to new offices in Alexandria, Virginia when we called. The file was located on around March 17, 2004, and our Washington associate went to Alexandria to copy the last Office Action and the Notice of Abandonment. I attach the facsimile cover page, the first page of the Office Action, and the file jacket index received from our Washington Associate on March 17, 2004 (Exhibit 9). I sent the Office Action by facsimile that same day to our client in the Netherlands (Exhibit 10).

17. On Monday, March 29, 2004, I sent an email reminder to our client for instructions (Exhibit 11). On April 5, 2004, I received a response by email including instruction for a response to the Office Action. They noted that their client had to confer with the licensee, and asked about the possibility of claiming that the abandonment was unavoidable in order to avoid filing a terminal disclaimer. We received this further inquiry on May 13, 2004 (Exhibit 12). We replied to their inquiry on May 14, 2004, explaining that a terminal disclaimer was required even if the abandonment was deemed unavoidable (Exhibit 13).

18. We filed the petition by Express Mail on May 28, 2004. On June 1, 2004, we received written authorization confirming prior oral authorization from the client to file a petition to revive which we had sent them in draft form (Exhibit 14).

19. In summary, at no time between June 1996 and February 2004 were we aware of the abandonment of the application. During that entire time period, neither the attorneys

at Cooper & Dunham, nor the European Patent Attorneys at Vereenigde, nor personnel at the University of Leiden, the assignee of the present application, nor Seed Capital Investments, the investor, had any intention to abandon the present application, nor did they have any knowledge that it had gone abandoned until we checked PAIR in February 2004. Thus, from September 1996, the time from which a reply to the June, 1996 Office Action was first due, until present date, there has been no intention on the part of applicants or their attorneys to abandon the present application. The entire delay during this time period was unintentional, and arose from the failure to receive the Office Action and the lack of awareness that an Office Action had issued for this application.

20. We acted with reasonable diligence in pursuing revival of this application. Upon discovery of the problem, we immediately search for and located the file in our office, and sent a power to inspect to our Washington associates. We promptly ordered the file from the USPTO as soon as we learned the application had gone abandoned. We pursued the search for the file when we learned it had been misplaced at the PTO. We promptly sent the file to the client as soon as we received the copy, and reminded them to respond. We filed a petition to revive as soon as we had authorization from the client. We allowed as little time to elapse as possible between the time we received the copy of the documents from the PTO and the filing of the initial petition to revive.

21. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: August 18, 2004

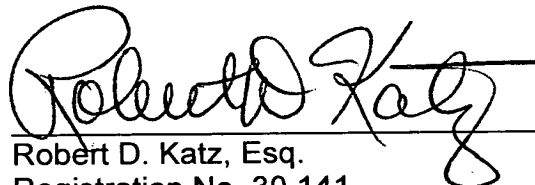

Robert D. Katz

WHEREFORE, applicants respectfully submit that they have fulfilled the requirements for a grantable petition to revive under 37 C.F.R. § 1.137(b), and respectfully request that this renewed petition be granted. In the alternative, applicants respectfully petition for suspension of the rules pursuant to 37 C.F.R. §181, and submit that the foregoing as well as all accompanying documents, declaration, and exhibits, constitute good and sufficient grounds for granting such a petition. Applicants' undersigned attorney can be telephoned (at 212-278-0424) if the Petitions Examiner has any questions or needs any additional information or documents.

The Commissioner is hereby authorized to charge any fees required or credit any overpayments dispersed in connection with the filing of this Renewed Petition to Revive to Deposit Account No. 03-3125. If any extension of time is required under 37 C.F.R. § 1.136 (a) or (b), applicants hereby request same and authorize the Commissioner to charge the fee therefore to Deposit Account No. 03-3125.

Dated: August 18 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert D. Katz", with a horizontal line drawn through the middle of the signature.

Robert D. Katz, Esq.
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